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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,653	09/12/2003	Toshiki Taguchi	Q77476	7569

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EXAMINER


SHAH, MANISH S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/660,653	Applicant(s) TAGUCHI ET AL.	
	Examiner Manish S. Shah	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-20, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/18; 1/30; 4/16</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 & 21, drawn to a sheet for inkjet recording & a method of inkjet recording using the sheet, classified in class 347, subclass 105.
 - II. Claims 11-20 & 22-23, drawn to an ink for ink jet recording & a method of inkjet recording using the ink, classified in class 347, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the invention I is a sheet for inkjet recording medium and invention II is an ink for inkjet recording, both the invention are totally different.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Mr. Raul Tamayo on 12/22/2004 a provisional election was made without traverse to prosecute the invention of group I,

claims 1-10 & 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-20 & 22-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sismondi et al. (# EP 1080936).

Sismondi et al. a sheet for ink jet recording, including: a support ([0024]); and a coloring material-receiving layer ([0030]) containing a mordant ([0042]) and a compound represented by the formula: $(R_k)_p-N-[L_m-(COOM_n)_q]_r$ or $R-N-(L-COOM)_2$; wherein R represents an alkyl group, an aryl group or a heterocyclic group; when a plural number of Rs are present, the plurality of Rs may be the same or different; at least two of a

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plurality R's may be linked with each other to form a cyclic structure; L represents divalent or higher linking group; M represents a hydrogen atom, an alkali metal cation, an ammonium ion, an organic amine cation, or a negative ion sign; q and r each represents an integer of 1 or more; k and m each represents 0 or an integer of 1 or more; n represents an integer of 1 or more; p represents 0 or an integer of 1 or more; (p+r) is 3 or 4, and when (p+r) is 4, the N atom represents a quaternary ammonium cation and one of the M's represents a negative ion sign; and at least one of R and L in the formula contains a hydrocarbon group having 8 or more carbon atoms ([0047]-[0052]). They also disclose that the receiving layer further contains a water-soluble resin, which is selected from polyvinyl alcohol and gelatins ([0031]-[0032]); and a fine particle, which is selected from the group including of silica, colloidal silica and alumina ([0038]). They also disclose that the ink-receiving layer further contains a crosslinking agent, which is boron compound ([0041]). They also disclose the inkjet recording method including recording an image by using the recording sheet (see Examples).

8. Claims 1-10 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Malhotra et al. (# US 5500668).

Malhotra et al. a sheet for ink jet recording, including: a support ([0024]); and a coloring material-receiving layer (see Abstract; column: 18, line: 50-65) containing a mordant (column: 11, line: 25-60) and a compound represented by the formula: $(R_k)_p-N-[L_m-(COOM_n)_q]_r$ or $R-N-(L-COOM)_2$; wherein R represents an alkyl group, an aryl group or a heterocyclic group; when a plural number of Rs are present, the plurality of Rs may

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be the same or different; at least two of a plurality R's may be linked with each other to form a cyclic structure; L represents divalent or higher linking group; M represents a hydrogen atom, an alkali metal cation, an ammonium ion, an organic amine cation, or a negative ion sign; q and r each represents an integer of 1 or more; k and m each represents 0 or an integer of 1 or more ; n represents an integer of 1 or more ; p represents 0 or an integer of 1 or more; (p+r) is 3 or 4 , and when (p+r) is 4 , the N atom represents a quaternary ammonium cation and one of the M ' s represents a negative ion sign; and at least one of R and L in the formula contains a hydrocarbon group having 8 or more carbon atoms (column: 15, line: 15-65; column: 16, line: 1-60). They also disclose that the receiving layer further contains a water-soluble resin, which is selected from polyvinyl alcohol and gelatins (column: 18, line: 53-65); and a fine particle, which is selected from the group including of silica, colloidal silica and alumina (column: 24, line: 40-60). They also disclose that the ink-receiving layer further contains a crosslinking agent, which is boron compound (column: 25, line: 1-15). They also disclose the inkjet recording method including recording an image by using the recording sheet (see Examples).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manish S. Shah
Primary Examiner
Art Unit 2853


MSS
12/23/04